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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,709	04/30/2001	Mohan L. Sanduja	1067-107	3925

23117 7590 03/10/2005  
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EXAMINER

EGWIM. KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/844,709

Applicant(s)

SANDUJA ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-16,26,27 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16,26,27 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>063004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The information disclosure statement filed 06/30/2004 has been considered to the extent that is possible from the abstracts and the disclosure for those documents, 94001947/04, 93014656/26, 2149166 and 97104027/04, not in the English language.

#### ***Specification***

2. The amendment filed 01/06/03 is still objected to under 35 U.S.C. 132, for reasons stated in the last Office action mailed 05/26/2004, because it introduced new matter into the disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14, 27, 36 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for reasons stated in the last Office action, mailed 05/26/2004. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 102/103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 8-16, 26, 27 and 34-37 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horowitz (U.S. 3,401,049, as applied to claims 8-10, 12-16 & 34), Horowitz et al. (U.S. 5,232,748) or Sanduja et al. (U.S. 6,368,369), for reasons stated in the last Office action, mailed 05/26/2004.

***Response to Arguments***

7. Applicant's arguments filed 12/08/2004 have been fully considered but they are not persuasive.
8. Regarding the arguments against the objection to the specification, the Examiner still fails to find direct support for the "sodium metabisulfite" recited in the objected amendments to specification. There still remains insufficient support for the amendment in the originally file disclosure.

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9. With regard to the 35 U.S.C 112, first paragraph rejections, as with the objection to the amendments to the specification, there is insufficient support for these amendments to the claims in the originally file application.

It is not the responsibility of one skilled in the art to reinterpret or distinguish what applicant meant to claim from that applicant is claiming. "Sodium metabisulfite" is distinct from "sodium metabisulfate" and the rejection is maintained.

10. Regarding applicant's argument that "the three cited references do not disclose the requisite coating composition that is suitable and effective in chemically grafting to an oil, fuel, coolant or air filter material and increases its filtration efficiency," as stated in the last Office action, while some of the prior art may not recite the use of the disclosed composition for the chemical grafting of a fuel, the use of the prior art compositions for the chemical grafting of an oil, fuel, coolant or air filter material would be obvious since the compositions are essentially the same as the claimed composition. The onus to show that this in fact is not the case has been shifted to applicants. It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicants to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product. See *In re Spada* 15 USPQ 2d 1655 (CAFC 1990). In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

11. Regarding Horowitz ("049 or ',748) or Sanduja et al., based on what is taught by each reference, it is believed that the rejections under 35 U.S.C. 102(b or e) or, in the alternative, under 35 U.S.C. 103(a) are met.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE



KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER